

REMARKS

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 57-63, 65, 66, 70, 74 and 90 are rejected and claims 64, 67-69, and 71-73 are objected to. Claims 57-74 and 90 are pending in this application.

Rejection Under 35 U.S.C. § 102(e)

Claims 57-63, 65, 66, 70 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,648,916 to Manduley (hereinafter "Manduley").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *See* M.P.E.P. § 2131; *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131; *citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 57 recites

A system for delivering information to a selected location from a transmitting location, said system comprising:

a transmission station operable at said transmitting location and adapted to transmit said information to an intermediate location; and

an intermediate station operable at said intermediate location and adapted to receive said information transmitted by said transmitting station, wherein said intermediate station comprises:

a converter circuit adapted to electronically receive said transmitted information and to convert said transmission to electronic form if said transmitted information is not initially in electronic form; and

a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location. (emphasis added)

In the Current Action the Examiner points to Manduley, at col. 2 lines 52-67, as satisfying "wherein the reproducing circuit also produces an indicia of payment authorizing delivery of

the human readable information to the selected location.” *See* Current Action, pg. 3. Applicant notes that, according to Manduley, “internally generated physical mail” is sent to equipment 27, which determines the amount of postage that is due and prints the correct amount of postage on the envelope. *See* Manduley at col. 2 lines 52-58; *also see* Figs. 1 & 2. The only information disclosed by Manduley as receiving an indicia of payment is internally generated at building 30 (which the Examiner equates to the claimed “intermediate location”). However, according to the claim, information receiving an indicia of payment is first transmitted from a transmitting location and received at an intermediate location. Clearly, Manduley’s mail that receives and indicia of payment, which is internally generated at building 30, has not been transmitted from a transmitting location and received at an intermediate location, as set forth in the claim. As such, Manduley does not satisfy this claim limitation.

Claims 58-63, 65, 66, 70 and 74 depend from claim 57 and inherit every limitation therefrom. As shown above, Manduley does not teach every limitation of claim 57. Therefore, claims 58-63, 65, 66, 70 and 74 set forth limitations not taught by Manduley and are patentable at least through their depending upon claim 57. Further, claims 58-63, 65, 66, 70 and 74 set forth additional limitations not taught by Manduley.

For example, claim 58 recites “wherein said intermediate location is selected according to proximity to said selected location.” Applicant points out that Manduley teaches, at Figs. 1 & 2, communication between mailroom 11 (which the Examiner equates to a transmitting location) and building 30 (which the Examiner equates to an intermediate location). Applicant notes that Manduley does not teach a selected location as set forth in the claims, much less an intermediate location (i.e., building 30) in proximity to a selected location. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 59 recites “wherein said intermediate location selection is accomplished automatically by said transmitting location through reference to address information with respect to said selected location.” Applicant points out that Manduley teaches, at Figs. 1 & 2, communication between mailroom 11 (which the Examiner equates to a transmitting location) and building 30 (which the Examiner equates to an intermediate location). Applicant notes that Manduley does not teach a selected location as set forth in the claims,

much less intermediate location selection accomplished automatically through reference to address information with respect to a selected location. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 61 recites a converter circuit comprising “circuitry adapted to accept electronic documents communicated utilizing different communication protocols.” In the Current Action the Examiner points to Manduley’s scanners 20 and 25 and computers 17 and 18, as satisfying a converter circuit. However, as seen in Manduley’s Fig. 1, information scanner 20 and 25 only accept physical documents (e.g., “fast physical mail” and “internally generated physical mail”). *Also see* Manduley at col. 2 lines 52-67. As such, Manduley does not teach circuitry adapted to accept electronic documents at all, much less those communicated using different communication protocols. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 63 recites a converter circuit “comprising circuitry adapted to determine delivery address information with respect to said selected location from information contained within said transmitted information.” In the Current Action the Examiner points to Manduley’s scanners 20 and 25 and computers 17 and 18, as satisfying a converter circuit. Applicant notes, however, that scanner 20 “will transmit the electronically scanned letter to personal computer 17, work station 18, or a facsimile machine 19, or printer 21.” *See* Manduley at col. 2 lines 25-30. Applicant notes that each of personal computer 17, work station 18, or a facsimile machine 19, or printer 21 are located in building 30 (which the Examiner equates to the claimed “intermediate location 30”). As such, Manduley merely determined delivery address information with respect to locations within an intermediate location (e.g., building 30). Manduley does not determine delivery address information with respect to a selected location, as set forth in the claim. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 66 recites “means for funding the delivery of said transmitted information.” In the Current Action, the Examiner points to Manduley at col. 2 lines 52-67, as satisfying this limitation. At this citation, Manduley discloses that mail “internally generated” at building 30 is metered and then sent to a mailroom. However, as discussed above, the claimed “transmitted information” is transmitted from a transmitting location and received at an

intermediate location. Clearly, Manduley's internally generated mail has not been transmitted from a transmitting location and received at an intermediate location, and therefore, is not "transmitted information" as set forth in the claims. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 70 recites "wherein said ancillary information includes a delivery address of said selected location." Applicant points out that Manduley teaches, at Figs. 1 and 2, communication between mailroom 11 (which the Examiner equates to a transmitting location) and building 30 (which the Examiner equates to an intermediate location). Applicant notes that Manduley does not teach a selected location as set forth in the claims, much less a delivery address of a selected location. Therefore, Applicant requests withdrawal of the rejection of record.

Claim 74 recites "wherein said reproducing circuit is operable at least in part with corresponding circuitry disposed at said selected location." Applicant points out that Manduley teaches, at Figs. 1 and 2, communication between mailroom 11 (which the Examiner equates to a transmitting location) and building 30 (which the Examiner equates to an intermediate location). Applicant notes that Manduley does not teach a selected location as set forth in the claims, much less circuitry disposed at a selected location. Therefore, Applicant requests withdrawal of the rejection of record.

Rejection Under 35 U.S.C. § 103(a)

Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of U.S. Patent No. 5,859,967 to Kaufeld (hereinafter "Kaufeld").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria are satisfied, Applicant respectfully asserts that the Examiner's rejection fails to satisfy the third criteria.

Claim 90 depends from claim 57 and inherits every limitation therefore. As shown above, Manduley does not teach or suggest every limitation of claim 90. Moreover, Kaufeld is not relied upon to teach or suggest the missing limitation, nor does it do so. As such, the Examiner's proposed combination fails to teach or suggest every limitation of Applicant invention. Therefore, Applicant requests withdrawal of the rejection of record.

Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P012US/10105074 from which the undersigned is authorized to draw.

Dated: November 30, 2006

Respectfully submitted,

By 

Michael A. Papalas
Registration No.: 40,381
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8186
(214) 855-8200 (Fax)
Attorney for Applicant